

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:) ATTY'S DKT: CLASSEN=6A
)
John Barthelow CLASSEN) Appeal No. 2009-004501
)
Appln. No.: 10/081,705)
) Washington, D.C.
Filed: February 21, 2002)
) October 25, 2010
For: COMPUTER ALGORITHMS AND)
METHODS OF PRODUCT SAFETY)

**PETITION UNDER 37 C.F.R. § 41.3 AND 1.8(b) AND
CONDITIONAL PETITION UNDER 37 C.F.R. § 1.183**

U.S. Patent and Trademark Office
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

Applicant hereby petitions under 37 C.F.R. § 41.3 and 37 C.F.R. § 1.8(b) for acceptance of the Reply Brief, the Request for Oral Hearing, the Declaration by Evelyn H. McConathy, the Declaration by John Barthelow Classen, and the transmittal letter, as having been timely filed on August 1, 2008. If necessary, Applicant further petitions under 37 C.F.R. § 1.183, for waiver of the requirement of 37 C.F.R. § 1.8(b) that the petition be filed "promptly." Applicant is submitting herewith Declarations by Evelyn H. McConathy, James Gannon, and John Barthelow Classen, and associated exhibits in support of this petition.

I. STATEMENT OF FACTS

1. On March 31, 2008, Applicant' counsel, Evelyn McConathy, timely filed an Appeal Brief, with 7 Exhibits and a Transmittal Letter. Exhibit A; McConathy Declaration, ¶ 3.

2. When paying the government fee for the Appeal Brief, Applicant's counsel also paid the government fee of \$515 for an Oral Hearing. See Exhibit A; McConathy Declaration, ¶ 3.

3. The first page of the Appeal Brief states "An oral hearing is requested." Exhibit A, page 3.

4. As is evidenced by the copy of the Appeal Brief downloaded from PAIR, Applicant's Counsel understood that the Oral Hearing fee had been processed and accepted by the PTO. Exhibit A, page 3; McConathy Declaration, ¶ 4.

5. The Examiner's Answer was mailed on June 3, 2008, and on August 1, 2008, Applicant's counsel filed a Reply to the Examiner's Answer, a separate Request for Oral Hearing, two declarations, accompanying exhibits, and a transmittal letter. Exhibit B; McConathy Declaration, ¶ 5.

6. The papers were filed using the Certificate of Mailing procedure of 37 C.F.R. § 1.8. Exhibit B, pages 2 and 3; McConathy Declaration, ¶ 5 and 9-11.

7. All individuals at Ms. McConathy's firm who were involved in any filing with the PTO were fully aware of the importance that filings be properly handled because dates are so important to their practice. McConathy Declaration, ¶ 6.

8. As a result, at that time it was their standard practice that papers were hand carried to the mailroom and hand delivered to the Head of their Mailroom for delivery either by U.S. Postal Service Express Mail or U.S. Postal Service First Class Mail. McConathy Declaration, ¶6.

9. Also as a further standard practice, after the filing had been posted by the mailroom, the secretary or paralegal responsible for the filing then confirmed to Ms. McConathy that the package had been accepted for mailing by the Mailroom. McConathy Declaration, ¶ 6.

10. It was and is Ms. McConathy's normal practice that the individual responsible for filing the papers at the US PTO confirms to her when each filing has been completed.. McConathy Declaration, ¶ 6.

11. Normally, when return receipt postcards are received from the PTO, the Intellectual Property paralegal would add the return postcard to the corresponding file. McConathy Declaration, ¶ 7.

12. Both in September of 2008 and recently, Ms. McConathy reviewed the files for this case, and did not find a post card. McConathy Declaration, ¶ 6.

13. It is thus Ms. McConathy's present understanding that they did not receive the return postcard in this case. McConathy Declaration, ¶ 7.

14. Similarly, any Express Mail receipt with respect to an application filing is eventually placed in the file. McConathy Declaration, ¶ 7.

15. When Ms. McConathy reviewed the file, no such Express Mail receipt was present with respect to the August 1, 2008, filing. McConathy Declaration, ¶ 7.

16. Ms. McConathy recently confirmed that there is a billing record for \$1.85 for postage billed to their firm's docket number for this case on August 1, 2008, providing further corroboration that the papers were mailed on that day by first class mail, but with a signed Certificate of Mailing under Section 1.8. McConathy Declaration, ¶ 10.

17. The fee would have been substantially higher if the mail had been sent by Express Mail. McConathy Declaration, ¶ 10.

18. Thus, this is evidence that the package had been mailed on August 1, 2008, by first class mail. McConathy Declaration, ¶ 10.

19. On September 27, 2008, Applicant's counsel, Evelyn McConathy, was checking the PAIR record for this case, and discovered that the Reply Brief, and the accompanying papers, were not there. McConathy Declaration, ¶ 8.

20. Ms. McConathy notified James Gannon, a paralegal at her firm, Montgomery, McCracken, Walker & Rhoads, LLP, in an email (Exhibit C) that the papers filed on August 1, 2008, in connection with the above-identified application were not showing up in PAIR, and asked him to look into this situation. McConathy Declaration, ¶ 8; Gannon Declaration, ¶ 4.

21. Upon reviewing the files, Ms. McConathy learned that Ms. Powell had signed the certificates of mailing for the August 1, 2008, filing, and also the Postage Voucher for First Class Mail (Exhibit D). McConathy Declaration, ¶ 9.

22. To the best of Ms. McConathy's knowledge, Ms. Powell had, in fact, deposited the papers with the firm's Mailroom Department, physically handing the papers to the

person in charge, after signing the certificate of mailing and they, in turn, deposited the filing in the U.S. first class mail on August 1, 2008. McConathy Declaration, ¶ 9.

23. As was Ms. McConathy's normal practice, had she not received confirmation from Ms. Powell that the filing was complete, she would have made further inquiries before going home that night. McConathy Declaration, ¶ 9.

24. Ms. Powell was a qualified and experienced IP secretary. McConathy Declaration, ¶ 9.

25. Ms. McConathy has no reason to believe that Ms. Powell did not follow the normal office procedures when filing the Reply Brief and accompanying papers. McConathy Declaration, ¶ 11.

26. When learning the fact that the filing was missing from PAIR, Ashley Powell was horrified, and repeatedly assured Ms. McConathy that she had filed the papers properly and that every procedure had been followed regarding hand-depositing the filing with our mailroom, and that the Mailroom knew that it had to be mailed on that day. McConathy Declaration, ¶ 11.

27. Ashley Powell departed from Ms. McConathy's firm in the spring of 2009. McConathy Declaration, ¶ 12.

28. Ms. McConathy and others at her firm have tried to contact Ms. Powell, in preparation for this paper, but have been unsuccessful. McConathy Declaration, ¶ 12.

29. On September 29, 2008, to the best of his recollection, Mr. Gannon consulted the MPEP regarding the procedure for the subsequent establishment of a filing date when the USPTO has no record of receipt of the filing. Gannon Declaration, ¶ 5.

30. Mr. Gannon reviewed 37 C.F.R. §1.8, taking note of both 37 C.F.R. §1.8(b), which provided for the resubmission of papers, as well as 37 C.F.R. §1.8(c), which indicated that the USPTO could also require additional evidence to determine if the correspondence was timely filed. Gannon Declaration, ¶ 6.

31. Mr. Gannon then placed a series of telephone calls to the USPTO to determine if the filing appeared on their internal system, and if not, what documents, including the additional evidence referenced in 37 C.F.R. §1.8(c), would be required to establish the earlier filing date. Gannon Declaration, ¶ 6.

32. Mr. Gannon called Examiner Etienne LeRoux and his supervisor, Apu Mofiz, and left messages for them both. Mr. Mofiz returned his call later that day. Gannon Declaration, ¶ 7.

33. Mr. Gannon informed Mr. Mofiz that they had filed papers on August 1, 2008, that were not showing up in PAIR. Gannon Declaration, ¶ 8.

34. Mr. Mofiz said that they were not in the system and that he could not say whether or not they were received by the PTO. Gannon Declaration, ¶ 9.

35. Mr. Mofiz indicated that, because the response was filed via the United States Postal Service, the USPTO would require a stamped, return postcard to subsequently establish receipt of the filing. Gannon Declaration, ¶ 10.

36. Mr. Gannon told Mr. Mofiz that they did not have such a postcard in their possession. Gannon Declaration, ¶ 10.

37. Mr. Mofiz then informed Mr. Gannon that, lacking such proof, they that should wait to see if the filing would eventually appear in PAIR. Gannon Declaration, ¶ 10.

38. Mr. Gannon inquired about the possibility of withdrawing the Appeal to have the Declarations admitted. Gannon Declaration, ¶ 11.

39. Mr. Mofiz indicated that a Request for Continued Examination (RCE) would remove the case from Appeal and once again place it in prosecution, allowing for entry of the Declarations. However, Mr. Mofiz suggested that Mr. Gannon contact the Board of Patent Appeals and Interferences to confirm this fact. Gannon Declaration, ¶ 11.

40. Mr. Gannon then called the Board of Patent Appeals and Interferences, where he was referred to Vasco Harper, a paralegal. Mr. Harper and Mr. Gannon discussed the filing of an RCE, and Mr. Harper stated that he, too, believed the filing of an RCE would suffice to remove the Appeal and once again place the application in prosecution, allowing for entry of the Declarations. Gannon Declaration, ¶ 12.

41. On September 30, 2008, Mr. Gannon reviewed the MPEP regarding the procedures for filing an RCE and the effect this would have on a currently pending Appeal. Gannon Declaration, ¶ 13.

42. Additionally, Mr. Gannon placed a telephone call to the main switchboard of the USPTO, and to the best of his recollection, he was connected to the Board of Patent Appeals and Interferences, though he is now unable to recall the individual with whom he spoke. The firm's telephone records show only a general Patent Office Exchange number. Gannon Declaration, ¶ 13.

43. The purpose of this call was to confirm the substantive effect of filing of an RCE, and how his own interpretation of the MPEP was in agreement with the opinions of Mr. Mofiz and Mr. Harper. Gannon Declaration, ¶ 13.

44. On October 1, 2008, Mr. Gannon placed a telephone call to the USPTO and was referred to Stan Miller of the Inventor's Assistance Center, where, to the best of his recollection, he confirmed Mr. Gannon's understanding of the procedural requirements for the filing of an RCE. Gannon Declaration, ¶ 14.

45. As part of Mr. Gannon's standard practice, he would have provided rolling reports to Ms. McConathy after having spoken with the USPTO. As such, he would have provided Ms. McConathy with rolling reports on at least September 29th, September 30th, and October 1st, 2008, regarding the information provided to Mr. Gannon by the USPTO on each respective day. Gannon Declaration, ¶ 15; McConathy Declaration, ¶ 13.

46. Mr. Gannon told Ms. McConathy that, as she suspected, Supervisory Examiner Mofiz said that a return postcard would be requested as additional evidence, and as a result, he was told to wait to see if the papers showed up in PAIR. McConathy Declaration, ¶ 13.

47. Mr. Gannon also explained that the individuals with whom he spoke at the US PTO had confirmed that Ms. McConathy's plan to file a Request for Continued Examination ("RCE") to enter both the completed Classen Declaration with the signed Letter of Original Invention, and to also restart the prosecution would resolve the issue. McConathy Declaration, ¶ 13.

48. This would have effectively caused the Appeal to be withdrawn, although a subsequent Appeal would have been permitted after the file was completed with the Classen Declaration. McConathy Declaration, ¶ 13.

49. Ms. McConathy was, and continues to be, aware of all parts of Rule 1.8. McConathy Declaration, ¶ 14.

50. However, it was Ms. McConathy's experience in the past, when PTO filings have disappeared, that in each case she had received the postmarked return postcard for that filing. As a result in those cases, she had the required additional evidence of delivery to the US PTO, which she considered to be demanded under 1.8(c). McConathy Declaration, ¶ 14.

51. In this case, because Ms. McConathy had no postmarked return postcard, although she did have a copy of the postcard sent as part of the filing, and a copy of the signed Certificate of Mailing under 37 C.F.R. § 1.8 on the August 1, 2008, Transmittal Sheet, her experience dictated that she had insufficient evidence under 1.8(c), even if timely filed in compliance with 1.8(b). McConathy Declaration, ¶ 14.

52. For this reason, Ms. McConathy asked Mr. Gannon to contact the US PTO to determine alternatives to the additional evidence requirement under 1.8(c) when the postmarked return postcard had, in fact, not been returned. McConathy Declaration, ¶ 14.

53. If it had been clear to Ms. McConathy after seeking advice from the PTO that the postmarked return postcard would not be required, she would have promptly filed a Petition under 1.8. McConathy Declaration, ¶ 14.

54. But Mr. Gannon was told that the postmarked return postcard would be required, and Ms. McConathy's own past experience told her that was true. McConathy Declaration, ¶ 14.

55. The alternative solutions were to wait for the papers and postcard to appear, or to file an RCE, or a combination thereof. McConathy Declaration, ¶ 14.

56. Ms. McConathy's understanding that a post-card receipt would be required to establish a date of receipt of the papers in question was consistent with the

information Mr. Gannon learned when calling the PTO and asking what needed to be filed to establish a date of receipt for the papers in question. McConathy Declaration, ¶ 14; Gannon Declaration, ¶ 7-10.

57. In light of Ms. McConathy's understanding at the time, and given the PTO's verbal recommendation that they either wait, or file an RCE, it was her judgment at the time that filing a Petition in this matter at the end of September 2008 without any postmarked return postcard seemed futile. McConathy Declaration, ¶ 15.

58. As a result, Ms. McConathy asked her client for permission to file an RCE to reopen the prosecution in this matter, so that the Declaration could be properly submitted and the Appeal could then be restarted, making the missing paper irrelevant. Exhibit E; McConathy Declaration, ¶ 15.

59. Ms. McConathy also knew that the Patent Examiner had lost this case for several years previously, so she was not surprised that these papers were lost, and fully expected that they, too, would eventually turn up. McConathy Declaration, ¶ 15.

60. Since Ms. McConathy had paid the government fee for an oral hearing, and had requested an oral hearing informally in the Appeal Brief, she believed that with the addition of the separately filed Request for Oral Hearing, that an oral hearing would be scheduled. McConathy Declaration, ¶ 16.

61. The separate Request for Oral Hearing was lost in the mail with the Reply. McConathy Declaration, ¶ 16.

62. Ms. McConathy, based on instructions from Applicant, had planned on filing an RCE with amended claims, thereby withdrawing the appeal, but several times, and for a

variety of reasons, the client asked her to wait before preparing the RCE. McConathy Declaration, ¶ 16.

63. An Appeal sits in the queue for several years at the US PTO, and work on the RCE remained in flux with the client. McConathy Declaration, ¶ 16.

64. The Appeal Board then made its decision without the requested Oral Hearing, even though payment had been acknowledged by the US PTO on PAIR. McConathy Declaration, ¶ 16.

65. The Decision of the Board of Patent Appeals and Interferences was issued in this case on August 23, 2010. Exhibit R.

66. Dr. Classen worked with Ms. McConathy, a patent attorney at the firm of Montgomery, McCracken, Walker & Rhoads, LLP, very closely to prosecute this application. Classen Declaration, ¶ 2.

67. She reported to Dr. Classen the filing of the Reply Brief and Request for Oral Hearing in a letter dated August 15, 2008. Exhibit QO; Classen Declaration, ¶ 3.

68. During the period from August 15, 2008, until July 19, 2010, with the exception of between March 2009 and November 2009, Dr. Classen was working with Ms. McConathy to draft amended claims to submit in an RCE. Classen Declaration, ¶ 4.

69. It was their intention that the RCE would be filed once they received notice from the Board of Patent Appeals and Interferences of the scheduling of the oral hearing that they had requested. Classen Declaration, ¶ 4.

70. In March 2009, Dr. Classen instructed Ms. McConathy to temporarily stop work on the RCE so that he could consider whether to proceed with the Appeal. Exhibit M; Classen Declaration, ¶ 5.

71. In November 2009, a copending application was allowed, which again raised in Dr. Classen mind the possibility of drafting amended claims in this case that could be successful before the Examiner, so he suggested that she start back to work on the claims. Exhibit N; Classen Declaration, ¶ 4.

72. On July 19, 2010, because of a large outstanding balance that Dr. Classen owed the firm, and that they had been requesting payment for, he instructed Ms. McConathy to temporarily discontinue working on the RCE. Exhibit O; Classen Declaration, ¶ 6.

73. On September 30, 2008, Ms. McConathy said that “we can stay with the Appeal as filed, but the odds are quite high that the Declarations and supporting evidence will not be considered on Appeal....” Exhibit E; Classen Declaration, ¶ 7.

74. This confirmed Dr. Classen’s belief that the Reply Brief and attached Declarations reported to him as having been filed in August 2008, were part of the PTO record. Classen Declaration, ¶ 7.

75. At no time between August 2008, and July 19, 2010, did Ms. McConathy or anyone else inform Dr. Classen that the PTO had not received the Reply Brief, Request for Oral Hearing, and the Declarations submitted with those papers. Classen Declaration, ¶ 8.

76. In fact, during that time, Dr. Classen repeatedly asked Ms. McConathy for status updates, and was told that she was working, but that there was no rush. Exhibits F-J and O; Classen Declaration, ¶ 8.

77. It was not until after the Board of Appeals and Patent Interferences had issued its decision and Dr. Classen expressed his surprise, and asked her what happened, that Ms. McConathy told him of the non-receipt of the papers. Exhibits K-L; Classen Declaration, ¶ 9.

78. Had Ms. McConathy informed Dr. Classen that the PTO had not received the Reply Brief, the Request for Oral Hearing, and the accompanying Declarations and Exhibits, and that because of that, they were going to get a decision at the Board without consideration of those papers, and that there was a way to refile the papers before filing the RCE, Dr. Classen would have instructed her 1) to do what it took to refile the papers; or 2) to file the RCE immediately, and, if necessary, file the amended claims at a later time. Classen Declaration, ¶ 10.

79. Dr. Classen would not have told her to stop work under those circumstances, because the costs of filing the RCE were relatively small, and he would not have wanted to risk getting a decision without the Board being in possession of all of the evidence they had. Classen Declaration, ¶ 10.

80. As it was, Dr. Classen felt comfortable in ordering temporary halts in the work on the RCE claims from time to time, because of billing and payment issues, because he was of the impression that the decision would not issue before the oral hearing took place. Classen Declaration, ¶ 11.

II. STATEMENT OF ACTION REQUESTED

Applicant requests, pursuant to 37 CFR 1.8(b), that the copies of the papers mailed on August 1, 2008, with a certificate of mailing under 37 CFR 1.8(a) be accepted as having been timely filed. If necessary, Applicant further requests that the portion of 37 C.F.R.

§1.8(b) requiring that the Office be informed of its non-receipt of the papers “promptly after becoming aware that the Office has no evidence of receipt of the correspondence” be waived. Applicant further requests that the Board’s Decision of August 23, 2010, be withdrawn as having been improvidently issued without considering the request for oral hearing and the reply brief and accompanying papers timely filed on August 1, 2008. Finally, Applicant requests that this file be returned to the Board of Patent Appeals and Interferences for consideration of the reply brief and accompanying papers filed on August 1, 2008, and for scheduling of an oral hearing as timely requested both in the appeal brief filed March 31, 2008, and the separate request of oral hearing filed August 1, 2008, the fee therefor having been paid on March 31, 2008.

III. ARGUMENT

A. The Present Petition Should be Granted as Fully Complying with 37 C.F.R. §1.8(b)

Applicant requests that the Reply Brief, Transmittal Letter, Request for Oral Hearing, two Declarations and accompanying exhibits first filed by Applicant’s former counsel on August 1, 2008, using the certificate of mailing procedures of 37 C.F.R. § 1.8(a), but which were not received in the PTO, copies of which are being submitted herewith, be accepted as having been timely filed.

Rule 1.8 provides:

(b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the U.S. Patent and Trademark Office after a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence, or after the application is held to be abandoned, or after the proceeding is dismissed or decided with prejudice, . . . , the correspondence will be considered timely if the party who forwarded such correspondence:

- (1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;
- (2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and
- (3) Includes a statement that attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing, transmission or submission. . . .

(c) The Office may require additional evidence to determine if the correspondence was timely filed.

The Manual of Patent Examining Procedure (“MPEP”), Section 512, provides:

IV. ORIGINAL MAILED PAPER NOT DELIVERED

Paragraphs (b) and (c) of 37 CFR 1.8 concern the situation where a paper containing a Certificate was timely deposited in the U.S. Postal Service, transmitted by facsimile or transmitted via EFS-Web, but never received by the U.S. Patent and Trademark Office. In the TCs, all submissions under these paragraphs should be considered and the sufficiency thereof determined by the TC Director. The statement required by 37 CFR 1.8(b)(3) is no longer required to be verified.

37 CFR 1.8(b) permits a party to notify the Office of a previous mailing through the U.S. Postal Service, or transmission by facsimile or EFS-Web, of correspondence when a reasonable amount of time has elapsed from the time of mailing or transmission of the correspondence. In the event that correspondence may be considered timely filed because it was mailed or transmitted in accordance with 37 CFR 1.8(a), but was not received in the Office after a reasonable amount of time has elapsed, (e.g., more than one month from the time the correspondence was mailed), applicant is not required to wait until the end of the maximum extendable period for reply set in a prior Office action (for the Office to hold the application abandoned) before informing the Office of the previously submitted correspondence. Applicant may notify the Office of the previous mailing or transmission and supply a duplicate copy of the previously mailed or transmitted correspondence and a statement attesting on a personal knowledge basis or to the satisfaction of the

Director to the previous timely mailing or transmission. If the person signing the statement did not sign the certificate of mailing or the certificate of transmission, then the person signing the statement should explain how they have firsthand knowledge of the previous timely mailing or transmission. Such a statement should be filed promptly after the person becomes aware that the Office has not received the correspondence.

Before notifying the Office of a previously submitted correspondence that appears not to have been received by the Office, applicants are encouraged to check the private Patent Application Information Retrieval (PAIR) System to see if the correspondence has been entered into the application file.

Under Rule 1.8(b), if an Applicant uses the certificate of mailing and the PTO does not receive or cannot locate the papers, Applicant can resubmit the papers, and the papers will be considered to have been timely filed on the date set forth on the certificate of mailing if certain conditions are met. In this case, Applicant urges the PTO to find that the requirements of Rule 1.8(b) have been met.

The present petition complies with 37 C.F.R. §1.8(b). With respect to paragraph (1), while Applicant's counsel had previously informally advised personnel at the PTO that papers had been filed on August 1, 2008 (see SOF 31-37), the present petition serves as formal notification to the PTO that the Reply Brief, Request for Oral Hearing, Declaration and attachments had been filed on August 1, 2008. The present petition and the copies of the previously filed papers are being submitted promptly after Applicant, Dr. Classen, became aware that the PTO had never received these documents. SOF 75-77. As will be discussed in detail below, due to the fact that Applicant's counsel concealed from Applicant Classen the fact that the papers had never been received by the PTO and that she had taken no action to remedy the situation, the knowledge and inaction of Applicant's counsel cannot be imputed to Applicant.

Nevertheless, if the “promptly” requirement of this paragraph is considered not to be met in this situation, it is requested that it be waived in accordance with 37 C.F.R. §1.183, for the reasons discussed in detail below.

With respect to paragraph (2) of 37 C.F.R. §1.8(b), copies of all the documents as transmitted by first class mail on August 1, 2008, with the certificates of mailing in accordance with 37 C.F.R. § 1.8(a) are submitted herewith.

As to paragraph (3) of 37 C.F.R. §1.8(b), on August 1, 2008, Applicant’s counsel filed a Reply Brief, along with a Transmittal Letter, a Request for Oral Hearing, two Declarations and accompanying exhibits. SOF 5. A certificate of mailing signed by an employee of Applicant’s counsel’s law firm establishes that the papers were timely filed. SOF 6. Although no stamped postcard receipt was found (SOF 12-13), such a receipt is not needed to establish a date of filing under 37 C.F.R. § 1.8(b). Obviously, there can be no postcard returned by the PTO if the PTO never received the papers in the first place. The papers filed on August 1, 2008, included proper certificates of mailing. SOF 6. The declaration of Evelyn McConathy filed concurrently with this petition, testifies to her signing of the reply brief, and her understanding regarding the actions that would have been taken by Ashley Powell, the person who signed the certificate of mailing. SOF 5-18 and 21-26. Ms. McConathy’s declaration corroborates the signature of Ashley Powell to establish that the reply brief and the accompanying papers were timely filed on August 1, 2008, by being deposited for mailing in First Class Mail. SOF 5-18 and 21-26.

B. Applicant is Acting Promptly in Filing this Petition

37 C.F.R. § 1.8(b)(1) provides that an applicant must inform the PTO of the previous mailing of the correspondence that was not received by the PTO “promptly after becoming aware that the Office has no evidence of receipt of the correspondence.” While this petition is being filed over two years after the signing of the certificate of mailing, it is still being filed promptly after Applicant Classen became aware that the PTO had no evidence of receipt of the correspondence.

Upon realizing that the reply brief and accompanying papers she had filed on August 1, 2008, were not of record in the PTO, Applicant’s counsel did what she was required to do under 37 C.F.R. § 1.8. She notified the PTO verbally that the reply had been filed but had not shown up in PAIR.¹ SOF 20 and 31-33. She also confirmed for herself that the papers had actually been filed by being deposited in First Class mail. SOF 7-13 and 21-26.

Applicant’s counsel did not immediately do everything it was required to do under Rule 1.8(b) by “promptly” providing a copy of the filed papers and the evidence that the papers had been timely filed. This was in part because, in response to her inquiries, Applicant’s counsel was given misleading, if not incorrect, information by the PTO, when they called to inform the PTO that they had filed the papers. SOF 31-44. As a result of what Applicant’s

¹ Although the only requirement for prompt action appears in 37 C.F.R. § 1.8(b)(1) and there is no requirement that the copy of the previously mailed correspondence or the statement attesting to the previous timely mailing be filed promptly, Applicant will assume the intent of the regulation is that the promptness requirement in subparagraph (1) also applies to subparagraphs (2) and (3).

counsel was told by the PTO, and in light of her own past experience, she incorrectly determined that it would have been futile to file the appropriate papers under 37 CFR 1.8(b). SOF 53-56. In light of Ms. McConathy's understanding at the time, and given the PTO's verbal recommendation that they either wait or file an RCE, it was her judgment at the time that filing a petition in this matter at the end of September 2008 without any postmarked return postcard would have been futile. SOF 57. As a result, Ms. McConathy decided not to take action in accordance with 37 CFR 1.8(b) and instead, without informing the client that the papers had never been actually received by the PTO and without explaining the ramifications thereof, requested permission from her client to file an RCE with amended claims and the declarations filed with the reply brief could be formally made of record in the prosecution of the case. SOF 58.

Ms. McConathy did not advise her client at that time that the PTO did not consider the reply brief, request for oral hearing, declarations, or exhibits to have been timely filed on August 1, 2008, or her decision not to petition for the timely entry of those papers. SOF 75. The client did not learn of this until after receipt of the Board Decision. SOF 76-77. Additionally, Applicant's counsel knew or should have known, that despite the fact that the Appeal Brief included an informal request for oral hearing, and the fee for the oral hearing had been processed and accepted by the PTO, without the addition of the separately filed Request for Oral Hearing, which was never received by the PTO, an oral hearing would not be scheduled. Nevertheless, Applicant's counsel never informed Applicant Classen that no notice of oral hearing, which would have given them sufficient notice of the deadline by which the RCE would

have to be filed before receiving a decision on the appeal, would be forthcoming because of her decision not to petition under 37 C.F.R. 1.8(b) for the entry of that document. SOF 60.

Before Applicant could complete and file the intended RCE, the Board issued its decision. SOF 64-65. Even though the applicant, Dr. Classen, intended to file an RCE with amended claims and the declarations belatedly filed with the reply brief, rather than continue with the appeal, Dr. Classen in good faith believed that he would have notice before a decision was issued in the form of notice of the setting of an oral hearing date. SOF 58, 62, 67-77. Instead, Dr. Classen now has an added burden of having to contend with the prosecution estoppel that will result from the decision in any further prosecution. Applicant did not become aware of the fact that the papers of August 1, 2008, had not been received by the PTO until shortly after issuance of the Decision of August 23, 2010. SOF 77. Applicant then hired new counsel and steps were promptly taken to gather all of the facts around why the papers had not been received, why no petition had ever been filed for their entry, and why the Applicant was never informed of this situation by his then counsel.²

² The time between Applicant's learning of the non-receipt by the PTO of the papers and the filing of this petition is not unreasonable given the need to review the files, and gather the required information. *In re Lonardo*, 17 U.S.P.Q.2d 1455, 1457 (Comm'r 1990) ("Though two months have passed from the time when he first learned that the '365 application had gone abandoned, that does not constitute excessive delay in light of the need to gather facts relating to events of more than 14 years ago.").

This paper is being filed reasonably promptly after Applicant gained this knowledge, thereby complying with the promptness requirement of 37 C.F.R. § 1.8(b) (1). For the reasons to be discussed below, the actions and knowledge of Applicant's then counsel should not be imputed to him in light of these circumstances.

C. Counsel's Error in Failure to Promptly Petition for Entry of the Non-Received Papers and Neglecting to Inform the Client is Not Chargeable to the Client

Applicant is aware of the general rule that the neglect or exercise of judgment of an attorney is chargeable to his client. However, in this case, Applicant's attorney's intentional failure to report the PTO's non-receipt of the reply brief and accompanying documents deprived Applicant of a viable opportunity to cure the consequences of the attorney's error. The Commissioner of Patents has ruled in *In re Lonardo*, 17 U.S.P.Q.2d 1455, 1457-1458 (Comm'r 1990), as follows:

When an attorney intentionally conceals a mistake he has made, thus depriving the client of a viable opportunity to cure the consequences of the attorney's error, the situation is not governed by the stated rule in [*Link v. Wabash R.R.*, 370 U.S. 626, 633-34 (1962)] for charging the attorney's mistake to his client. See *Jackson v. Washington Monthly Co.*, 569 F.2d 119, 122 n.18 (D.C. Cir. 1977):

The gross-neglect rule of [*L.P. Steuart, Inc., v. Matthews*, 329 F.2d 234, 235 (D.C. Cir. 1964), *cert. denied*, 379 U.S. 824 (1964)] has been criticized as discordant with *Link*. 7 J. Moore, *Federal Practice* ¶60.27[2], at 369-370 n.47 (2d ed. 1975); see *United States v. Cirami*, 535 F.2d 736, 740-741 (2d Cir. 1976). But even if that were so, an attorney's deception of a blameless client would survive as a basis for relief under Rule 60(b)(6). See 7 J. Moore, *supra*, ¶60.27[2], at 368 n.44. When a client does not knowingly and freely acquiesce in his attorney's neglectful conduct, but instead is misled into believing that the attorney is

industrious, dismissal is not only a harsh step but one for which the circumstances provide little support for an agency theory as a rationale. *Cf. Thane Lumber Co. v. J.L. Metz Furniture Co.*, 12 F.2d 701, 703 (8th Cir. 1926); *Chamberlain v. Amalgamated Sugar Co.*, 42 Idaho 604, 247 P. 12, 14 (1926).

Here, Applicant's counsel deceived Applicant about the fact that the PTO did not have the Request for Oral Hearing and other papers mailed on August 1, 2008. Applicant repeatedly inquired of his counsel as to the status of the case, and while at times Applicant instructed his counsel to temporarily suspend work on the amended claims and RCE, he did so without any knowledge that there was a risk in doing so due to his counsel's mistakes and the failure of counsel to report those mistakes and the consequences thereof. SOF 69-77. At best, even if counsel did not believe that any mistakes had been made (contrary to the facts of record), she should have at least reported to the client that the PTO was treating the August 1, 2008, submission as never having been received and her belief (albeit mistaken) that there was nothing she could do about that, and her knowledge that no notice of oral hearing would be received before issuance of a decision on the appeal. The facts here compel a conclusion that these errors by counsel cannot be charged to Applicant. Thus, counsel's failure to promptly file a 1.8(b) petition cannot be imputed to Applicant. Accordingly, this paper is being file within a reasonable time after Applicant became aware of the non-receipt of the August 1, 2008, papers by the PTO.

D. If Necessary, the Promptness Requirement of 37 C.F.R. §8(b)(1) Should be Waived

In the event that a determination is made that the promptness requirement of 37 C.F.R. § 1.8(b)(1) has not been complied with in this case, notwithstanding the facts and

reasoning cited above, Applicant requests that the requirement of Rule 1.8(b)(1) that the PTO be promptly informed be waived, and that the present paper be considered as having been timely filed. 37 C.F.R. § 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

Applicant submits that the present fact situation is extraordinary, and that justice requires that the reply brief and the request for oral hearing be entered at this time. In this case, Applicant's counsel of record misunderstood the applicable law and further made an error of judgment. She listened to the advice of a PTO patent examiner, and based on that, and her misunderstanding of the provisions of Rule 1.8, incorrectly concluded that filing a petition under Rule 1.8 would have been futile. SOF 57.

It is not equitable or in the interests of justice for Applicant to be punished for this misreading of the law and reliance on the incorrect advice of an examiner, when Applicant's counsel should have known that examiners do not rule on 1.8(b) submissions and therefore would have no basis for giving advice thereon. *See MPEP 512(IV) (“[i]n the TCs, all submissions under these paragraphs should be considered and the sufficiency thereof determined by the TC Director.”)* However, that is just what she did. Applicant requests that the Board Decision be withdrawn and the papers properly filed on August 1, 2008, considered before reissuance of a Decision, so as to avoid the unjust result of penalizing Applicant for his counsel's mistake and his counsel's intentional failure to timely inform the Applicant of that mistake.

Moreover, the incompetence of Applicant's attorney in believing that a return postcard would be required despite the fact that 1.8(b) refers to the situation where the paper was never received by the PTO and therefore issuance of a return receipt postcard would have been impossible, is extraordinary. Applicant's counsel mistakenly, and inexplicably, believed that a postcard would be required based on her reading of Rule 1.8(c). However, any reasonable and competent practitioner would understand that the incorrectly perceived requirement for proof of receipt by a return receipt postcard would vitiate the intent of Rule 1.8(b) to permit a paper with a certificate of mailing to receive a date of filing as of the date the certificate of mailing was signed **even if the paper was lost in the mail and never received by the PTO**. Rule 1.8(c) is independent and separate from the requirements of Rule 1.8(b). This point is brought home by even the most cursory review of MPEP 512(IV). If an applicant is claiming that his filing was lost in the mail, obviously he would not have a postcard receipt. In that case, it would be unreasonable to believe that the PTO would require a postcard receipt. It would render the provisions of Rule 1.8(b), which permits an applicant to obtain a filing date of papers based on the signed certificate of mailing, ineffective, because an applicant could never have a returned post card receipt if the papers were lost by the U.S. mail.

As indicated above, Applicant's former counsel did not tell Applicant about the problem with the filing of the reply brief and request for oral hearing, or explain the consequences that could result if the problem was not fixed, until after the Decision had issued. SOF 66-77. Had Applicant been fully informed that the PTO did not have the reply brief or the request for oral hearing, and the Declarations filed therewith, he would have told counsel to either try to fix the problem or immediately file the RCE. SOF 78-79. Applicant felt

comfortable in ordering temporary halts in the work on the RCE claims from time to time, because of billing and payment issues, because Applicant was of the impression that the decision would not issue before the oral hearing took place. SOF 80.

An applicant is entitled to rely on the competence of his attorney. Here, Applicant's counsel made a significant error in interpretation and understanding of the law, and compounded the problem by failing to inform the Applicant that a problem had occurred and that it could be fixed by either filing the papers under Rule 1.8 or filing the RCE immediately. Thus, Applicant's counsel did not afford the Applicant an opportunity to make a fully informed decision about how to proceed. This resulted in substantial damage to the Applicant in light of the *res judicata* and estoppel effect of the decision on the prosecution of any RCE. Accordingly, the facts here compel a conclusion that this was an extraordinary situation, where justice requires that Applicant be permitted to rectify the situation. In this case, that means 1) accepting the reply brief, request for oral hearing, and the accompanying papers as having been timely filed on August 1, 2008; 2) withdrawing the Board's Decision of August 23, 2010; 3) returning the file to the Board for consideration of the reply brief and scheduling of an oral hearing.

E. A Request for Reconsideration is Being Concurrently Filed

Applicant is filing with the Board of Patent Appeals and Interferences a separate Request for Reconsideration of the Decision on Appeal, requesting that the decision be withdrawn, and an oral hearing be scheduled before the Board of Patent Appeals and Interference, in light of the facts presented herein. Once the decision is withdrawn, applicant intends to file an RCE with amended claims.

F. Authorization of Fee Payment

The required petition fee set forth under 37 CFR § 41.3/1.17(f) is being submitted herewith. It is requested, however, that this fee be refunded in the event that this petition is decided without the necessity of considering the contingent petition under 37 C.F.R. § 1.183. It is respectfully requested that any deficiency in the fees required to be paid in order to consider and rule on any part of this submission be charged to the deposit account of the undersigned, No. 02-4035.

IV. CONCLUSION

Accordingly, prompt consideration and granting of this petition and according the relief requested herein is earnestly solicited.

BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicant

By /Ronni S. Jillions/
Ronni S. Jillions
Registration No. 31,979

RSJ:me
Telephone No.: (202) 628-5197
Facsimile No.: (202) 737-3528
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